

REMARKS

Claim Rejections

Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sadlo et al. (5,670,223) in view of Suzuki et al. (WO 03/047062 A1).

Amendments to Specification

Applicant has amended the Specification as noted above to correct the reference numeral for the first projecting portion and to provide proper antecedent basis in the specification for reference numeral --24--. It is believed that the foregoing amendments to the Specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the Specification.

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, except as discussed above, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-5 and has added new claims 6-11 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a support core ribbon for a cold-shrink tube, the cold-shrink tube including an elastomeric tube and a tubular support core deposited in the elastomeric tube for supporting the elastomeric tube, the tubular support core formed by the support core ribbon being wound helically, the support core ribbon comprising: a continual ribbon (20) being a flat body having: a first edge (21) having a first straight groove (211) and a first projecting portion (212) located on a top surface of the continual ribbon; a second edge (22) connected to the first

edge and having a second straight groove (221) and a second projecting portion (222) located on a bottom surface of the continual ribbon, the first edge is connected to the second edge by inserting the first projecting portion into the second straight groove and the second projecting portion into the first straight groove; at least one groove (23, 25) located between the first and the second edges; and a plurality of through holes (24) spaced apart an equal distance along a length of the at least one groove.

Other embodiments of the present invention include: the at least one groove is a single V-shaped groove (23); the at least one groove includes two V-shaped grooves (25), a first groove of the two V-shaped grooves is located on the top surface of the continual ribbon; a second groove of the two V-shaped grooves is located on the bottom surface of the continual ribbon aligning with the first groove; the first edge and the second edge fixed together by ultrasonically welding; the plurality of through holes are a plurality of square holes extending through the flat body; and each of the plurality of square holes having two opposing corners aligning with the bottom of the at least one groove.

The primary reference to Sadlo et al. teaches a ribbon (20) having each of two edges (22, 24) having a projection and a recess.

Sadlo et al. do not teach at least one groove located between the first and the second edges; a plurality of through holes spaced apart an equal distance along a length of the at least one groove; the at least one groove includes two V-shaped grooves, a first groove of the two V-shaped grooves is located on the top surface of the continual ribbon; a second groove of the two V-shaped grooves is located on the bottom surface of the continual ribbon aligning with the first groove; the plurality of through holes are a plurality of square holes extending through the flat body; nor do Sadlo et al. teach each of the plurality of square holes having two opposing corners aligning with the bottom of the at least one groove.

The secondary reference to Suzuki et al. teaches a tearable core member having v-notches (34, 34').

Suzuki et al. do not teach a plurality of through holes spaced apart an equal distance along a length of the at least one groove; the at least one groove includes two V-shaped grooves, a first groove of the two V-shaped grooves is located on the

top surface of the continual ribbon; a second groove of the two V-shaped grooves is located on the bottom surface of the continual ribbon aligning with the first groove; the plurality of through holes are a plurality of square holes extending through the flat body; nor do Suzuki et al. teach each of the plurality of square holes having two opposing corners aligning with the bottom of the at least one groove.

Even if the teachings of Sadlo et al. and Suzuki et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a plurality of through holes spaced apart an equal distance along a length of the at least one groove; the at least one groove includes two V-shaped grooves, a first groove of the two V-shaped grooves is located on the top surface of the continual ribbon; a second groove of the two V-shaped grooves is located on the bottom surface of the continual ribbon aligning with the first groove; the plurality of through holes are a plurality of square holes extending through the flat body; nor does the combination suggest each of the plurality of square holes having two opposing corners aligning with the bottom of the at least one groove.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Sadlo et al. or Suzuki et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Sadlo et al. nor Suzuki et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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